

REMARKS

In this Response, claims 43-51 are currently pending, of which claims 43, 50, and 51 are independent. No new matter has been added.

Applicant thanks the Examiner for withdrawing the 35 U.S.C. § 101 rejection of claim 50.

I. Summary of Examiner Interview

Applicant thanks the Examiner for the courtesy of the telephone interview on January 7, 2009. During the interview, the Applicant's position that the cited references are not enabling prior art and do not render obvious the pending claims was discussed. In addition, the Applicant's position that the cited references do not qualify as prior art was discussed.

II. Summary of Claim Rejections

Claims 43, 50, and 51 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0195729 to Kodosky et al. (hereinafter "Kodosky '729").

Claims 44-49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kodosky '729 in view of U.S. Patent Application Publication No. 2003/0196187 to Kodosky et al. (hereinafter "Kodosky '187").

III. 35 U.S.C. § 102(e) rejection

The Examiner rejects claims 43, 50, and 51 as being anticipated by Kodosky '729 (Office Action, page 5, ¶ 1).

Applicant maintains that the Examiner has not made a prima facie case under 35 U.S.C. § 102(e) for at least the reasons presented below. In particular, Kodosky '729 does not qualify as a 35 U.S.C. § 102(e) reference because Kodosky '729 was filed nearly two years after the pending application was filed, and the subject matter relied upon in the rejection, namely claim 36 of Kodosky '729, is not entitled to an earlier filing date under 35 U.S.C. § 120. In the

alternative, Kodosky ‘729 cannot be used as a reference under 35 U.S.C. § 102(e) because the alleged anticipatory disclosure (i.e., claim 36) is not enabled (*see Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003)).

A. Summary of Relevant History

The present application was filed on July 20, 2001 and published on January 23, 2003 as U.S. Patent Application Publication No. 2003/0016206. Kodosky ‘729, on the other hand, was not filed until May 9, 2003, nearly two years after the filing of the pending application and more than three months after the publication of the pending application.

Claim 36 of Kodosky ‘729 is an identical, word-for-word copy of Applicant’s claim 1 as published. In addition, claim 36 of Kodosky ‘729 is completely unsupported in the specification of Kodosky ‘729. For example, claim 36 of Kodosky ‘729 recites “identifying portions of a model as being either critical to a real-time execution of the model or non-critical to a real-time execution of the model.” However, the written description in Kodosky ‘729 does not include the words *identifying, critical* or *non-critical* or any disclosure that can reasonably be construed as describing “identifying portions of a model as being either critical to a real-time execution of the model or non-critical to a real-time execution of the model.” Thus, the written description of Kodosky ‘729 provides no support for claim 36 and no support for disclosing the claim features of Applicant’s claims 43, 50, and 51.

The attorney drafting claim 36 of Kodosky ‘729 had ample opportunity to copy Applicant’s claim 1 because claim 1 was published more than three months before Kodosky ‘729 was filed. Since the written description of Kodosky ‘729 provides no support for claim 36, Applicant respectfully submits that claim 36 of the Kodosky ‘729 patent application is an intentional copy of the published claim 1 from the instant application.

The adversarial relationship between National Instruments, the assignee for Kodosky ‘729, and The MathWorks, Inc., the assignee for the pending application, may have motivated the copying. The MathWorks, Inc. and National Instruments compete and were engaged in litigation when the instant application published and when the Kodosky ‘729 application was filed. *See National Instruments Corp. v. The MathWorks, Inc.*, Civil Action No. 2:01-CV-

00011-TJW (E.D. Tex.); National Instruments Corp. v. The MathWorks, Inc., Civil Action No. 2:02-CV-0256-TJW (E.D. Tex.). See Exhibit A for case summaries from the Court Pacer docketing system.

For at least the reasons set forth above, Applicant respectfully submits that claim 36 was added to the Kodosky ‘729 patent application with the intention of preventing the currently pending application from being issued to a patent. Applicant, however, challenges the legal viability of using claim 36 of Kodosky ‘729 as a prior art reference against the claims in the instant application.

B. Claim 36 of Kodosky ‘729 is not a valid 35 U.S.C. § 102(e) reference

The Examiner states that claims 43, 50 and 51 are anticipated by Kodosky ‘729 because claim 36 of Kodosky ‘729 describes “identifying portions of a model as being critical to a real-time execution of the model” and “identifying other portions of the model as being non-critical to the real-time execution of the model” (Office Action, page 5, ¶ 2). Applicant respectfully disagrees because claim 36 of Kodosky ‘729 is not a valid 35 U.S.C. § 102(e) reference.

i. Kodosky ‘729 was filed after the present application

A 35 U.S.C. § 102(e) reference must be a patent or a patent application “filed in the United States before the invention by the applicant for the patent” under examination. Kodosky ‘729, however, was filed on May 9, 2003, nearly two years after the July 20, 2001 filing date of the present application. Thus, based on its filing date, Kodosky ‘729 is not a valid 35 U.S.C. § 102(e) reference.

ii. Claim 36 of Kodosky ‘729 is not entitled to an earlier priority date

The Examiner, however, alleges that Kodosky ‘729 claims a priority date of August 18, 1997 because it is a continuation of U.S. Patent Application No. 09/788,104 (hereinafter “the ‘729 parent application”), filed February 16, 2001, which is a continuation of U.S. Patent Application No. 08/912,427 (hereinafter “the ‘729 grandparent application”), filed August 18, 1997, now U.S. Patent No. 6,219,618 (Office Action, page 3, ¶ 1). Applicant respectfully disagrees.

MPEP 2136.03(IV) states that, pursuant to 35 U.S.C. § 120, “the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e)” (emphasis added).

Applicant asserts that the subject matter that the Examiner relies on, namely, claim 36 of Kodosky ‘729, is not disclosed in the parent applications of Kodosky ‘729 in compliance with 35 U.S.C. 112, first paragraph. Therefore, claim 36 of Kodosky ‘729 is not entitled to the filing date of the earlier parent applications.

a. The only subject matter relied on is claim 36 of Kodosky ‘729

The Examiner has only cited to claim 36 of Kodosky ‘729 in rejecting the claimed “identifying portions of a model as being critical to a real-time execution of the model” and “identifying other portions of the model as being non-critical to the real-time execution of the model.” The Examiner alleges that he “gave detail explanation of claimed limitation and pointed out exact locations in the cited prior art” in previous Office Actions. However, the only “detail” and “exact location” provided for these claimed features is “page 21, claim 36,” which was provided at page 5 of the current office action and on page 4 of the *previous* April 2, 2008, office action. Thus, the only subject matter recited is in claim 36 of Kodosky ‘729; there is no citation to any matter that predates the pending application, and thus, there is not a valid rejection.

b. The standard of disclosure is “sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention”

35 U.S.C. 112, first paragraph, requires the written description to “describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” MPEP 2163(I), citing Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003). Thus, in order for claim 36 of Kodosky ‘729 to qualify for an earlier filing date, the subject matter of claim 36 must be described in the parent applications of Kodosky ‘729 “in sufficient detail that one

skilled in the art can reasonably conclude that the inventor had possession of the claimed invention” (emphasis added).

c. Subject matter of claim 36 of Kodosky ‘729 is not described in earlier applications in sufficient detail to satisfy 35 U.S.C. § 112, first paragraph

Neither the ‘729 parent application nor the ‘729 grandparent application includes the words *critical* or *non-critical*. Thus, neither the ‘729 parent application nor the ‘729 grandparent application show that the inventor had possession of “identifying portions of a model as being critical to a real-time execution of the model” or “identifying other portions of the model as being non-critical to a real-time execution of the model.”

In addition, there is no basis to conclude that Kodosky implicitly had possession of “identifying portions of a model as being critical to a real-time execution of the model” or “identifying other portions of the model as being non-critical to a real-time execution of the model” at the time of filing the ‘729 parent or grandparent applications. The ‘729 parent and grandparent applications describe selecting portions of a graphical program for export to a hardware description. Such a selection can be performed without identifying portions of a model as being critical or non-critical to a real-time execution of a model. In fact, the selection portions may include both portions that are critical to a real-time execution of a model as well as portions that are not critical to a real-time execution of a model. Therefore, merely describing selecting portions of a graphical program for export to a hardware description does not show that the inventor had possession of “identifying portions of a model as being critical to a real-time execution of the model” or “identifying other portions of the model as being non-critical to a real-time execution of the model.”

Furthermore, if the ‘729 parent or grandparent application showed that the inventor had possession of “identifying portions of a model as being critical to a real-time execution of the model” and “identifying other portions of the model as being non-critical to a real-time execution of the model,” then the Examiner would be able to cite directly to those applications in the rejection of Applicant’s claims. There would be no need to cite Kodosky ‘729, which was filed nearly two years after the pending application was filed.

d. Subject matter of claim 36 is not inherent in the disclosures of the earlier applications

The Examiner alleges that “even if a prior art inventor does not recognize a function of his or her process, the process can anticipate if that function was inherent” (Office Action, page 3, ¶ 3).

Applicant asserts, however, that the subject matter of claim 36 is not inherent in the disclosure of the parent and grandparent applications of Kodosky ‘729. An inherent feature exists only if “the missing descriptive matter is necessarily present in the thing described in the reference” (MPEP 2163.07(a), citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)) (emphasis added). As explained above, it is not necessarily true that selecting portions of a graphical program for export to a hardware description would result in the identification of “portions of a model as being critical to a real-time execution of the model” or “other portions of the model as being non-critical to a real-time execution of the model” since the selected portions may include both portions that are critical to the real-time execution of the model as well as portions that are non-critical to the real-time execution of the model. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient” to establish inherency (*Id.*). Thus, the disclosures of the parent and grandparent applications of Kodosky ‘729 do not inherently support claim 36 of Kodosky ‘729.

If the Examiner maintains his rejection, the Examiner must rebut Applicant’s challenge to awarding an earlier filing date to claim 36 of Kodosky ‘729. In particular, the Examiner must show, with particularity, where and how the parent and/or grandparent applications of Kodosky ‘729 describe ““identifying portions of a model as being critical to a real-time execution of the model” or “identifying other portions of the model as being non-critical to a real-time execution of the model” in compliance with 35 U.S.C. 112, first paragraph.

If the Examiner argues that claim 36 is inherently disclosed in the parent or grandparent applications of Kodosky ‘729, MPEP 2112(IV) requires the Examiner to provide:

a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990)) (emphasis added).

MPEP 2112(IV) further requires that the Examiner provide:

objective evidence or cogent technical reasoning to support the conclusion of inherency (emphasis added).

The Examiner **does not** provide any *objective evidence or cogent technical reasoning to support the conclusion of inherency*. For example, the Examiner fails to cite to portions of the relevant written description in support of his inherency theory and fails to provide explanations as to how those portions inherently disclose claim 36 of Kodosky '729. More specifically, the Examiner's inherency argument merely describes the general principles of inherency. Thus, the Examiner's inherency argument is legally inadequate to support the Examiner's position.

For at least the reasons set forth above, Applicant asserts that the Examiner has not set forth a *prima facie* case of anticipation. Accordingly, Applicant respectfully requests the Examiner to reconsider and to withdraw the above 35 U.S.C § 102(e) rejection of claims 43, 50, and 51 because claim 36 of Kodosky '729 is not entitled to an earlier priority date, so it is not a valid 35 U.S.C. § 102(e) reference.

C. Kodosky '729 is not enabling

In the alternative, Applicant asserts that Kodosky '729 cannot be used as a reference under 35 U.S.C. § 102(e) because the alleged anticipatory disclosure (i.e., claim 36) is not enabled.

i. A prior art reference must be enabled to be anticipatory

A patent claim "cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." Elan Pharm., Inc. v. Mayo Found. for Med. Educ. & Research, 346 F.3d 1051, 1054 (Fed. Cir. 2003) (quoting Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed.Cir.2003)). Thus, if the allegedly anticipatory disclosures are not enabled, they cannot be used to anticipate Applicant's claims.

In particular, enablement requires that "the prior art reference must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation."

Minnesota Mining and Manufacturing Co. v. Chemque, Inc., 303 F.3d 1294, 1301, 64 USPQ2d 1270, 1278 (Fed.Cir.2002).

ii. Applicant may disqualify an alleged anticipatory reference by proving that the relevant disclosure in the reference is not enabled

Although the Examiner may reject an application without determining whether or not the prior art patent is enabled, the Federal Circuit notes that:

The applicant, however, can then overcome that rejection by proving that the relevant disclosures of the prior art patent are not enabled. Amgen, 65 USPQ2d at 1416 (Fed. Cir. 2003) (citing In re Sasse, 629 F.2d 675, 681, 207 USPQ 107, 111 (C.C.P.A. 1980)) (emphasis added).

Thus, the Federal Circuit states that Applicant may rebut the Examiner's rejection by arguing that "the relevant disclosures of the prior art patent are not enabled."

iii. Claim 36 of Kodosky '729 is not enabled

As discussed above, the Examiner only cites to claim 36 of Kodosky '729 in rejecting the "identifying portions of a model as being critical to a real-time execution of the model" and "identifying other portions of the model as being non-critical to the real-time execution of the model" features of Applicant's claims 43, 50, and 51 (Office Action, page 5, ¶ 2). Applicant asserts, however, that claim 36 of Kodosky '729 cannot be used to anticipate Applicant's claims 32, 50, and 51 because claim 36 of Kodosky '729 is not enabled.

a. Claim 36 is not explicitly enabled by Kodosky '729

Claim 36 of Kodosky '729 (i.e., "the relevant disclosure") is not enabled because the written description of Kodosky '729 is silent with respect to essential parts of claim 36, such as "identifying portions of a model as being either critical to a real-time execution of the model or non-critical to a real-time execution of the model." Instead, Kodosky '729 describes selecting portions of a graphical program for export to a hardware description. Because Kodosky '729 was merely focused on generating hardware implementations of graphical code, it is not surprising that the terms in claim 36, such as *critical* and *non-critical* cannot be found in the written description of Kodosky '729. Since Kodosky '729 does not describe "identifying

portions of a model as being either critical to a real-time execution of the model or non-critical to a real-time execution of the model,” Kodosky ‘729 fails to “teach one of ordinary skill in the art to make or carry out” identifying portions of a model as being either critical or non-critical to a real-time execution of a model “without undue experimentation.”

b. Claim 36 is not inherently enabled by Kodosky ‘729

The Examiner tries to refute Applicant’s arguments regarding enablement by implying that claim 36 of Kodosky ‘729 is inherently enabled (Office Action, pages 3-4). Applicant strenuously disagrees with the Examiner’s position.

As discussed above, inherency requires a characteristic that is necessarily present in the reference (MPEP 2163.07(a)). Kodosky ‘729 describes selecting portions of a graphical program for export to a hardware description. Performing such an operation does not necessarily result in “identifying portions of a model as being either critical to a real-time execution of the model or non-critical to a real-time execution of the model.” Thus, the relied-on portion of claim 36 is not an inherent characteristic of the process described in Kodosky ‘729. Accordingly, there is no basis to support an argument that Kodosky ‘729 inherently enables claim 36.

Furthermore, MPEP 2112(IV) requires an Examiner to provide:

a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,

as well as

objective evidence or cogent technical reasoning to support the conclusion of inherency (emphasis added).

As discussed previously, the Examiner failed to satisfy the requirements of MPEP 2112(IV) for establishing a rejection based on inherency because the Examiner merely stated general principles regarding inherency, without applying the principles to the current situation. Thus, the Examiner did not provide any *objective evidence or cogent technical reasoning to support the conclusion of inherency*.

Since Kodosky ‘729 neither explicitly nor inherently enables claim 36, claim 36 of Kodosky ‘729 cannot anticipate Applicant’s claims 43, 50, and 51. Therefore, Applicant asserts that the Examiner has not set forth a prima facie case of anticipation. Accordingly, Applicant respectfully requests the Examiner to reconsider and to withdraw the above 35 U.S.C § 102(e) rejection of claims 43, 50, and 51 because claim 36 of Kodosky ‘729 is not enabled, so it is not a valid 35 U.S.C. § 102(e) reference.

IV. 35 U.S.C § 103(a) rejection

The Examiner rejects claims 44-49 as being unpatentable over Kodosky ‘729 in view of Kodosky ‘187 (Office Action, page 5, § 6, ¶ 2). Claims 44-49 depend from and incorporate all of the features of claim 43.

Applicant maintains that the Examiner has not made a prima facie case under 35 U.S.C. § 103(a) for at least the reasons presented below. Specifically, claim 36 of Kodosky ‘729 does not qualify as prior art, and the remaining portions of Kodosky ‘729 and Kodosky ‘187 combined do not disclose or suggest each and every element of claims 44-49. In the alternative, the cited portions of Kodosky ‘187, namely claims 23-26, do not qualify as prior art because they are not entitled to the benefit of an earlier filing date.

A. Kodosky ‘729 and Kodosky ‘187 fail to remedy the disqualification of claim 36 of Kodosky ‘729 as prior art

The Examiner alleges that claims 44-49 are obvious at least in part because Kodosky ‘729 describes “identifying portions of a model as being critical to a real-time execution of the model” and “identifying other portions of the model as being non-critical to the real-time execution of the model” (Office Action, page 6, ¶ 1).

However, as discussed above, with respect to the 35 U.S.C. § 102(e) rejection of claim 43, claim 36 of Kodosky ‘729 is not entitled to an earlier priority date. Therefore, claim 36 of Kodosky ‘729 does not qualify as prior art and cannot be used in a 35 U.S.C. § 103(a) rejection against claims 44-49.

The Examiner has not indicated that any other portion of Kodosky ‘729 discloses or suggests “identifying portions of a model as being critical to a real-time execution of the model” and “identifying other portions of the model as being non-critical to the real-time execution of the model.” Instead, Kodosky ‘729 describes selecting portions of a graphical model for hardware execution. Thus, Applicant asserts that there is no basis to conclude that Kodosky ‘729 discloses or suggests the claimed features.

Kodosky ‘187 does not cure the shortcomings of Kodosky ‘729 with respect to “identifying portions of a model as being critical to a real-time execution of the model” and “identifying other portions of the model as being non-critical to the real-time execution of the model” because Kodosky ‘187 is silent with respect to these features. Instead, Kodosky ‘187 describes a graphical environment for enabling users to more easily develop embedded systems (Kodosky ‘187, ¶ [0014]).

For at least the reasons set forth above, Kodosky ‘729 and Kodosky ‘187, alone or in any reasonable combination, do not disclose or suggest each and every feature of claims 44-49. In addition, the Examiner has not set forth a prima facie case of obviousness since the rejection of claims 44-49 was based, in part, on claim 36 of Kodosky ‘729, which does not qualify as prior art. Accordingly, Applicant respectfully requests the Examiner to reconsider and to withdraw the above 35 U.S.C. § 103(a) rejection of claims 44-49.

B. Claims 23-26 of Kodosky ‘187 are not entitled to an earlier priority date

The Examiner acknowledges that Kodosky ‘729 does not disclose or suggest all of the features in Applicant’s claims 44-49 (Office Action, page 6, ¶ 1). However, the Examiner alleges that the missing features are described in claims 23-26 of Kodosky ‘187 (Office Action, page 6, ¶ 2). Applicant respectfully disagrees because claims 23-26 of Kodosky ‘187 are not valid 35 U.S.C. § 103(a) references.

i. Kodosky ‘187 was filed after the present application

Kodosky ‘187 was filed May 16, 2003, which is nearly two years after the July 20, 2001 filing date of the present application. Thus, based on its filing date, Kodosky ‘187 is not prior art, and therefore is not a valid 35 U.S.C. § 103(a) reference.

ii. Claims 23-26 of Kodosky ‘187 are not entitled to an earlier priority date

The Examiner, however, alleges that Kodosky ‘187 claims a priority date of August 18, 1997 because it is a continuation of U.S. Patent Application No. 09/631,528 (hereinafter “the ‘187 parent application”), filed August 3, 2000, which is a continuation of U.S. Patent Application 08/912,445 (hereinafter “the ‘187 grandparent application”), filed August 18, 1997, now U.S. Patent No. 6,173,438 (Office Action, page 3, ¶ 1). Applicant respectfully disagrees.

As discussed above with respect to the 35 U.S.C. § 102(e) rejection, 35 U.S.C. § 120 requires that the subject matter in a patent application must be supported in the parent application “as required by 35 U.S.C. 112, first paragraph” in order for that subject matter to receive the benefit of the filing date of the parent application. MPEP 2136.03.

Applicant asserts that the subject matter that the Examiner relies on, namely, claims 23-26 of Kodosky ‘187, are not disclosed in the parent applications of Kodosky ‘187 in compliance with 35 U.S.C. 112, first paragraph. Therefore, claims 23-26 of Kodosky ‘187 are not entitled to the filing date of the earlier parent applications.

iii. The ‘187 Examiner rejected claims 23-26 of Kodosky ‘187 under 35 U.S.C. § 112, first paragraph

During the prosecution of Kodosky ‘187 the ‘187 Examiner rejected claims 23-26 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. *See* June 7, 2007 Non-Final Office Action for U.S. Application No. 10/439,440, hereinafter “‘187 OA”. The ‘187 Examiner explained that:

The phrases “greater real-time response” and “lesser real-time response” in claims 1, 18, 23, 31-34 are not sufficiently defined or reasonably described in the Specifications as to enable one skill in the art to be apprised of the nature/scope of these limitations so to be able to reasonably make use of the invention. Nowhere in the Specifications is ever mentioned about a *real-time response* being *greater* or *lesser* with respect to any teaching; hence, the Applicant is deemed not in possession of these limitations at the time the invention was made. ‘187 OA, page 4, ¶ 7.

The ‘187 Examiner noted that dependent claims, such as claims 24-26, were similarly rejected for not remedying the deficiencies of the base claims. ‘187 OA, page 4, § 7. No response was

filed to the ‘187 Examiner’s rejection and the application was subsequently abandoned. *See* December 18, 2006 Notice of Abandonment for U.S. Application No. 10/439,440.

iv. The subject matter of claims 23-26 of Kodosky ‘187 is not described in earlier applications in sufficient detail to satisfy 35 U.S.C. § 112, first paragraph

Similarly, the ‘187 parent and grandparent applications also do not “ever mention … about a *real-time response* being *greater or lesser* with respect to any teaching.” Therefore, the ‘187 Examiner’s reasons for why Kodosky ‘187 does not satisfy 35 U.S.C. § 112, first paragraph, with respect to claim 23 also explain why the ‘187 parent and grandparent applications do not satisfy 35 U.S.C. § 112, first paragraph, with respect to claim 23. That is, the ‘187 parent and grandparent applications do not show that Kodosky was in possession of, for example, a “graphical program model including sections, a first subset of the sections designated post-processing unit sections requiring a lesser real-time response” on the filing date of the ‘187 parent and grandparent applications.

Furthermore, Applicant asserts that claims 23, 25, and 26 of Kodosky ‘187 refer to “designated post-processing unit sections,” but the written descriptions in Kodosky ‘187 and the ‘187 grandparent application do not include the terms *designated* or *post-processing*. Thus, Applicant asserts that these features are also not supported as required by 35 U.S.C. 112, first paragraph, in the written descriptions of the ‘187 parent and ‘187 grandparent applications, providing further support for why the relied on claims in Kodosky ‘187 are not entitled to the benefit of an earlier filing date.

v. Burden is on the Examiner to provide proof that claims 23-26 of Kodosky ‘187 are valid 35 U.S.C. § 103(e) references

The Examiner alleges that “a *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness.” (Office Action, page 4, ¶ 2) (emphasis added).

Applicant's position, however, is that the Examiner has not made a *prima facie* case of obviousness because the Examiner has not relied upon valid prior art, as set forth above. Thus, the Applicant has no duty to go forward with objective evidence of unobviousness. Instead, if the Examiner maintains his rejections, he is obligated to provide objective evidence for why the challenged portions of Kodosky '729 and Kodosky '187 qualify for the benefit of an earlier priority date since the Applicant has twice provided objective evidence for why Kodosky '729 and Kodosky '187 do not qualify for the benefit of an earlier priority date.

For at least the reasons set forth above, Applicant asserts that the Examiner has not set forth a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests the Examiner to reconsider and to withdraw the above 35 U.S.C. § 103(a) rejection of claims 44-49.

CONCLUSION

In view of the above amendments and arguments, Applicant believes the pending application is in condition for allowance and the claims should issue. Should the Examiner feel that a teleconference would expedite the prosecution of this application, the Examiner is urged to contact the Applicant's attorney at (617) 227-7400.

Please charge any shortage or credit any overpayment of fees to our Deposit Account No. 12-0080, under Order No. MWS-041RCE. In the event that a petition for an extension of time is required to be submitted herewith, and the requisite petition does not accompany this response, the undersigned hereby petitions under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized to be charged to the aforementioned Deposit Account.

Dated: April 13, 2009

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